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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,652	10/19/2001	Poh Leong Er	1008.P002US/HCH/mms	2676
35830	7590	02/27/2004	EXAMINER	
LAWRENCE N. GINSBERG 21 SAN ANTONIO NEWPORT BEACH, CA 92660-9112			COLE, LAURA C	
			ART UNIT	PAPER NUMBER
			1744	
DATE MAILED: 02/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/040,652

Applicant(s)

ER, POH LEONG

Examiner

Laura C Cole

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings were received on 29 December 2003. These drawings are acceptable.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the channel "communication" (Claim 28) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure or illustration in the Application regarding the channel communicating with the interior of the paint applicator or that the channel is of a diameter to permit pouring without the need of a funnel.

4. Claims 26-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for having a holder abutment being arc-shaped members (Figure 5; Specification Page 7 Lines 1-3) or having a holder abutment being a ring (Figures 1-4; Specification Page 5 Lines 10-12), does not reasonably provide enablement for having a holder abutment being both of arc-shaped members *and* a ring. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Again, the ring holder abutment and the arc-shaped member holder abutment are separate embodiments as indicated in the specification and are not combined.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 1 requires the channel to be "of sufficient diameter". It is unclear as to what "sufficient" is defined to be.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 24-26, 30-32, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Powers, USPN 3,253,290.

Powers discloses a surface treating element that comprises an applicator having a cylindrical outer surface and two ends (1a), two holder mounts (2) having a base surface (the interior surface) and further comprising a journal protruding from the base surface (2) comprising at least one holder abutment and having a planar abutment surface aligned on a common plane (the holder abutment being the portion surrounding (3), but not the spokes extending from it as seen in Figure 3). The total area of the planar abutment surface is smaller than an axial cross-section of each holder mount (as seen best in Figures 1 and 3), wherein the journal further comprises a cylindrical protrusion (3), wherein the at least one abutment forms a ring surrounding the cylindrical protrusions (see above, Figure 3), and wherein the at least one holder abutment forms a plurality of arc shaped members disposed about the protrusion (being the portions of (2) that are defined by (17) and are located at the end of the "spokes" that are farthest away from (3)). Further, Powers discloses an applicator holder having a handle (9) and a fork having opposite sides (6a and 6b), having a journal engagement portion comprising a loop (3a), the loop comprising a mount abutment surface (the interior portions of the fork loops surrounding (3a)) having an area larger than the total area of planar abutment surface of the journal (as seen in Figures 1 and 2), and wherein the area of the mount abutment surface is smaller than an axial cross section of each holder mount (as seen in Figures 1 and 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kessler, USPN 4,458,399.

Kessler discloses an ink roller that comprises a paint applicator having a cylindrical outer surface and two opposite ends (12), two holder mounts (32) having a base surface (interior surface of (32)) and further comprising a journal protruding from base surface (32) comprising a holder abutment (where leader line (32) is pointing in Figure 1), the holder abutment having a planar abutment surface (located on the "ridge-like" unlabeled circle on (32) in Figure 1). The total area of the planar abutment surface for each journal is smaller than the holder mounts (Figures 1-2), wherein the journal further comprises a cylindrical protrusion (36), wherein the holder abutment forms a ring surrounding the cylindrical protrusion (Figure 1). Kessler does not disclose a plurality of arc-shaped members disposed around the cylindrical portion.

It would have been an obvious matter of engineering choice to modify the shape of Kessler to contain arc-shaped members since such a modification would have involved a mere change in the shape or form of a component. A change in shape or form is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976).

8. Claims 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Er, USPN 6,036,392.

Er discloses a painting tool that comprises a paint applicator having a cylindrical outer surface and two opposite ends (2), two holder mounts (Exhibit A - Figure 4), two journals protruding from the base surface and further comprising at least one holder abutment aligned on a common plane (Exhibit A). Er further discloses that the total area of the planar abutment surface for the journal is smaller than an axial cross-section of each of the holder mounts (Exhibit A), wherein the journal further comprises a cylindrical protrusion (Exhibit A), and wherein the cylindrical protrusion forms a channel with an inner wall having at least one circumferential ridge (Exhibit A). Er further discloses a handle (12) and fork (7) having opposite sides (8) having a journal engagement portion (inner surface of the opposite sides), the journal engagement portion further comprising a loop (assemblies shown in Figures 1 and 2 make it inherent that the end walls (8) are in a loop shape to engage the cap and roller), the loop comprises a mount abutment surface having an area larger than the planar abutment surface (Exhibit B), the area of the mount abutment surface is smaller than an axial cross section of each of the holder mounts (Exhibits A and B). There is a cover for capping at least one of the holder mounts (6) and comprises a cylindrical portion having at least one perimeter ridge (Figure 2 (6)). Er does not disclose a plurality of arc-shaped members disposed around the cylindrical portion.

It would have been an obvious matter of engineering choice to modify the shape of Er to contain arc-shaped members since such a modification would have involved a

mere change in the shape or form of a component. A change in shape or form is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976).

9. Claims 24-28, 30, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mallindine, USPN 3,588,264 in view of Powers, USPN 3,253,290.

Mallindine discloses a paint roller that comprises a paint applicator having a cylindrical outer surface and two opposite ends (20) and two holder mounts (25 and 26) having a base surface (the interior surface) and further comprising a journal protruding from the base (16 and 17) comprising a holder abutment (interior surface of (16) or (17) facing inwards) having a planar abutment surface aligned on a common plane (exterior surface of (16) and (17)). The journal further includes a cylindrical protrusion (14), wherein the one holder abutment forms a ring surrounding the protrusion (Figure 6 either (14) or (18), (18) not being continuous with the piece (17)). The applicator holder has a handle (10) and a fork having opposite sides (12 and 13) having a journal engagement portion (interior surfaces of sides) and a loop (13a and 12a). There is a cover (18) for capping at least one of the holder mounts having a perimeter ridge (Figure 6 (18)). Mallindine does not disclose a plurality of arc-shaped members disposed around the cylindrical portion.

Powers disclose all elements above including a plurality of arc-shaped members.

It would have been obvious for one of ordinary skill in the art to modify the holder abutment of Mallindine for one of Powers for ergonomic reasons, decorative purposes, and, provides a greater rolling balance.



***Applicants Arguments***

10. In the response, filed 29 December 2003, the Applicant contends that:

A. The arc-shaped members of Powers do not exist to provide a reduced rotation resistance of the roller by using these members.

B. The invention of Jenking requires a funnel for use, as does Roux.

C. Er has an unexpectedly high rotational resistance in use.

D. A funnel is required when filling the roller of Mallindine.

E. Disassembly is required to fill the rollers of Kessler or Newman with ink.

F. The arc-shaped members of Powers have no relevance to the arc-shaped members of the claimed invention.

G. The arc-shaped members are not a mere change in the shape or form of the component, but are new and non-obvious improvements to the art.

***Response to Arguments***

11. Applicant's arguments A-G filed 29 December 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments A, F, and G that the arc-shaped members of Powers do not provide a reduced rotation resistance of the roller, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See

*In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to Arguments B and D, the need or not the need for a funnel is new matter to the Application, as mentioned above.

In response to applicant's arguments A, C, F, and G that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., rotational resistance) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument E that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that there is not a disassembly of the device to pour or remove paint) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C Cole whose telephone number is (571) 272-1272. The examiner can normally be reached on Mondays through Thursdays, and alternating Fridays, from 7:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden, can be reached at (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*LCC*

LCC

20 February 2004

*Robert J. Warden, Sr.*

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